PATENT: **Mail Stop AF**
Customer No. 22,852
Attorney Docket No. 05725.0993-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Sandrine DECOSTER et al.	Group Art Unit: 1617
Application No.: 10/018,796	Examiner: Gina C. Yu
Filed: December 21, 2001	Confirmation No.: 2464
For: COMPOSITION CONTAINING AN OPACIFIER OR PEARLESCENT AGENT AND AT LEAST TWO FATTY ALCOHOLS	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections set forth in the final Office Action mailed on May 17, 2006, the period for response having been extended to September 17, 2006 by a request for extension of one month and fee payment filed concurrently herewith. Applicants respectfully assert that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal; (3) this request is being filed prior to an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with the guidelines set forth in the Official Gazette Notice of July 12, 2005. Applicants request the prompt review of the Examiner's rejections set forth in the final Office Action.

I. Obviousness Rejection

In the final Office Action, claims 18, 20-28, and 30-51 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") in view of Sebag et al. (WO 98/03155) ("Sebag"). Applicants respectfully assert that this rejection is improper.

In order to establish a *prima facie* case of obviousness, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *See In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). The Examiner must meet three basic criteria: (1) the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and (3) there must be a reasonable expectation of success. *See* M.P.E.P. §§ 2143.01 - 2143.03. In the present case, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Alcohol Components

As recognized by the Examiner, "the example formulations [of Mitsumatsu] do not concurrently use stearyl and behenyl alcohol within a same composition as recited in the instant claims." *See* Final Office Action at 2. The Examiner then points to page 24, lines 19 and 20 of Mitsumatsu, which discloses that "[n]onlimiting examples of fatty alcohols include, cetyl alcohol, stearyl alcohol, behenyl alcohol, and mixtures thereof," as well as Examples 4 and 5 in Mitsumatsu in an attempt to support her obviousness

rejection. *See id.* at pages 2 and 3. However, Mitsumatsu's examples do not suggest, nor motivate one of ordinary skill in the art to substitute behenyl alcohol for cetyl alcohol, let alone suggest the *concurrent* use of stearyl and behenyl alcohol. Mitsumatsu merely discloses a non-limiting list of fatty alcohols and their derivatives, without providing any specific guidance that would motivate one of ordinary skill to arrive at a composition within in the scope of the present claims.

Moreover, Mitsumatsu does not suggest the amounts and ratios of the presently claimed composition. The Examiner argues that Mitsumatsu discloses "general conditions," however, those general conditions relate to formulations that differ from the presently claimed composition. Mitsumatsu's examples fall outside the scope of the present claims. Although the Examiner relies on Examples 4 and 5, the amount of stearyl alcohol used in these formulations is less than the claimed amount. At best, the substitution of behenyl alcohol for cetyl alcohol, and further, the modification of concentrations might be obvious to try. However, a determination of obviousness cannot be based on what the skilled person might try or find obvious to try. Rather, the proper test considers what the prior art would have actually led one of ordinary skill to do. *See In re O'Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988).

B. Opacifiers and/or Pearlescent Agents

The Examiner acknowledges that Mitsumatsu "fails to teach the opacifier/pearlescent recited in claims 19-25." *See* Final Office Action at 3. The Examiner relies upon Sebag to remedy this deficiency. However, as argued of record, Applicants submit that one skilled in the art would not have been motivated to modify Mitsumatsu in view of Sebag. Mitsumatsu teaches shampoo formulations comprising

triazole as an essential ingredient, with additional *optical brighteners* available "which have the same characteristics as the triazoles with respect to ultraviolet light absorption and visible light emission." Mitsumatsu, p. 39, lines 1-2. However, Mitsumatsu does not include opacifiers or pearlescent agents among the lengthy list of other additional components. *Id.* at p. 41, lines 9 - 28.

One of ordinary skill in the art would recognize that optical brighteners, as disclosed in Mitsumatsu, functionally differ from the presently claimed opacifiers/pearlescent agents. As argued in the February 10, 2006 Response, optical brighteners "absorb the invisible uv portion of the daylight spectrum and convert this energy into the longer-wavelength visible portion of the spectrum." *See, e.g.,* McElhone, Jr., Harold J., "Fluorescent Whitening Agents," Kirk-Othmer Encyclopedia of Chemical Technology (1994), at http://www.mrw.interscience.wiley.com/kirk/articles/fluomcel.a01/sect11.html. In contrast, opacifiers may be included in the formulation of a "surfactant solution at temperatures above their melting points and then crystallize upon cooling, producing a pearlescent appearance." *See* Reiger, Martin M., Ph.D., "Opacifying and Clarifying Agents," Harry's Cosmeticology, 8th Ed., Chemical Publishing Co., Inc., New York (2000) p. 623. In other words, optical brighteners achieve a brightening effect through fluorescence, while opacifiers achieve a pearlescent appearance through reflectance or light scattering.

Applicants respectfully submit that the optical brighteners of Mitsumatsu and the presently claimed opacifiers/pearlescent agents differ in both mechanism and function. However, the Examiner dismisses these differences, commenting that "the present

rejection is not based on any assumption that these agents somehow have [the] same functions." Final Office Action at 6. Applicants respectfully submit that it is in view of these fundamental differences that one of ordinary skill in the art would not have been motivated to substitute an opacifier for Mitsumatsu's optical brightener with a reasonable expectation of success.

Sebag doesn't remedy this deficiency. One of ordinary skill would not have been motivated to substitute an opacifier or pearlescent agent, such as dialkyl ether, for Mistumatsu's optical brightener. In fact, Sebag does not suggest that dialkyl ether is even responsible for the pearlescent effect. Without any suggestion or motivation, one of ordinary skill in the art would not have modified Mitsumatsu in view of Sebag with a reasonable expectation of success.

II. Conclusion

Based on the foregoing arguments, and incorporating the record herein, Applicants request that the § 103(a) rejection of the pending claims be withdrawn and the claims allowed. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 15, 2006

By: _____
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